

REMARKS

The December 13, 2002 Office Action rejected claims 1-17 over newly-cited art. In response to the Office Action, the applicant requested, and was granted, an Examiner Interview via telephone on March 7, 2003. The applicant thanks the Examiner for the interview and his comments regarding the differences between the present invention and the prior art references. The applicant further thanks the Examiner for his comments provided by e-mail on March 10, 2003. By this Amendment, independent claim 17 has been cancelled. Independent claims 1 and 12 and dependent claims 2-11 have been amended. Entry of this amendment and reconsideration of the outstanding rejections is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1, 2, 4-6, 9-13 and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman, U.S. Patent Number 4,839,829 ("Freedman"), in view of Seybold Report (a collection of articles cited in PTO-892 items: U and V) ("Seybold Report"). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman and Seybold Report, as applied to claim 1, in further view of Official Notice. Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman and Seybold Report, as applied to claim 1, in further view of Official Notice. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman and Seybold Report, as applied to claim 12, and further in view of Printing Impressions (PTO-892 Item:W).

The applicant respectfully submits that the present invention is not obvious over the prior art references cited in the Office Action. Claims 1-12 have been amended to more clearly define the present invention.

The Office Action acknowledged that the Freedman reference "does not disclose supplying the cost calculator to the requestor." Office Action, Page 4. The applicant notes this distinction and further points out that Freedman is designed to allow a user to design and configure a print job using expert system software. See col. 8, lines 67-68 – col. 9, lines 1-2; col. 9, lines 18-21 and 64-68. Once the user has designed the print job, Freedman calculates cost

information related to the print job based on alternative pricing strategies. The costs are provided to the user and then the user has the opportunity to select a particular printing facility or printing machine for production of the job. See col. 10, lines 15-24.

The Seybold Report, as explained in the Office Action, “teaches the current state of printing industry regarding use of the Internet and further teaches A&a Printers establishing an Internet web site using HTML that allows requesters to submit print job online and to estimate job costs before committing to the printing service using online estimating tools to calculate shipping-weight and spine-thickness.” Office Action, page 4.

The applicant respectfully submits that the present invention, specifically claims 1 and 12, is not obvious in view of the prior art references cited in the Office Action. The present invention accepts electronic print jobs that have been created by a customer and submitted via the Internet. Freedman, however, allows the customer to design and configure print jobs using its expert system software. While Freedman acknowledges that it can provide an estimation for “camera ready” documents if a customer “came to the printing facility,” or “contact[ed] the printing facility by telephone,” it does not disclose obtaining an electronic print job via the Internet. See col. 10, lines 67-68 – col. 11, lines 1-4.

The present invention further supplies the customer with a price calculator that allows the customer to obtain an automatic and instantaneous price quote for a print job based on printing configurations selected on the price calculator. Thus, the customer receives a new price quote each time the printing configurations are changed. This allows the customer to change numerous printing configurations, such as paper type and size, in addition to other options such as turn-around time, and compare the cost of various printing configurations. Freedman does not supply the price calculator to the customer, such that the customer can compare the cost of various printing configurations. Instead, the customer receives various cost alternatives based only on the printing facility or machine used to complete the print job. See col. 10, lines 15-24. Thus, Freedman does not disclose the pricing calculator of the present invention.

Seybold Report also fails to disclose the pricing calculator of the present invention. The pricing calculator of the present invention calculates a price quote for printing a job based on the printing configurations selected by the customer. The Seybold Report only discusses “shipping-

weight” and “spine-thickness” calculators. In addition, the calculators in the Seybold Report fail to calculate a set price. Instead, the price is only an estimate, requiring the customer to “call” the printer. Further, the Seybold Report cannot be used as a reference against the present invention because it does not provide an enabling disclosure of the calculators. “A reference contains an ‘enabling disclosure’ if the public was in possession of the claimed invention before the date of invention.” MPEP 2121.01. “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his [or her] own knowledge to make the claimed invention.” In re Donohue, 766 F.2d 531 (Fed. Cir. 1985). The Seybold Report simply mentions “shipping-weight” and “spine-thickness” calculators that can be used to “help customers estimate their costs for a proposed job.” The Seybold Report does not disclose how to make and use the calculators to estimate the costs. Specifically, the calculators do not automatically calculate costs based on printing configuration options. Thus, the Seybold Report fails to disclose the pricing calculator of the present invention.

In addition, the applicant submits that there is no motivation to modify the system and method of Freedman based on the Seybold Report. Freedman teaches an automated printing control system that utilizes networked computers, but makes no mention of the Internet. The Seybold Report, however, teaches the current state of the printing industry related to use of the Internet. In the absence of any motivation to combine references in the manner suggested in the Office Action, the claimed invention cannot be deemed obvious. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (“When a rejection depends on a combination of a prior art reference, there must be some teaching, suggestion, or motivation to combine the references.”); Grain Processing Corp. v. American Maize-Prod. Corp., 840 F.2d 902, 907 (Fed. Cir. 1991) (“Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.”).

Based on the failure of the prior art references to teach all the limitations of claims 1 and 12, and the lack of motivation to combine the prior art references, applicant believes claims 1 and 12 are not obvious in view of the prior art and in condition for allowance.

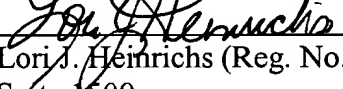
Dependent claims 2-11 and 13-16 each depend from and contain all the limits of independent claims 1 and 12, respectively. Thus, dependent claims 2-11 and 13-16 distinguish over the prior art for the same reasons recited above.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP
Customer Number 25763

Date: 3-13-03

By:  ✓
Lori J. Heinrichs (Reg. No. 43,667)
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498
(612) 752-7377